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09/558,755	04/21/2000	Devin F. Hosea	109.635.123	9034

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Rajesh Vallabh Esq
Hale and Dorr LLP
60 State Street
Boston, MA 02109

EXAMINER

BOYCE, ANDRE D

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/558,755

Applicant(s)

HOSEA ET AL.

Examiner

Andre Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Non-Final Office action is in response to Applicant's amendment filed January 21, 2003. Claims 11-13, 25, 26, 36, and 44 have been amended. Claims 1-63 are pending.
2. The previously pending objection to the specification has been withdrawn.
The previously pending objections to claims 11-13, 25, 26, 36, and 44 have been withdrawn.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 1-21 and 56-63 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological

arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the independent claim 1 only recites an abstract idea. The recited steps of providing a profile on a plurality of web sites, monitoring Web sites, and developing a user profile does not involve, use, or advance the technological arts, since the steps could be performed using pencil and paper.

Further, as to technological arts recited in the preamble (i.e., computerized method), mere recitation or implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea, **unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.**

In the present case, independent claim 56 only recites an abstract idea. The recited steps of providing a profile on a plurality of web sites, monitoring Web sites, inferring a profile of each user, identifying a target group of users, and selectively delivering content does not involve, use, or advance the technological arts, since the steps could be performed using pencil and paper.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case the claimed invention develops a user profile, thereby producing a useful, concrete, and tangible result, but not within the technological arts as explained above.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 7-9, 11-14, 20, 22-24, 26-57, and 62-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Roth et al (USPN 6,285,987).

As per claim 1, Roth et al disclose a method of profiling a Web user (via view-opportunity/view-op, see column 2, lines 11-14), comprising: providing profiles on a plurality of Web sites (web site demographics, see column 9, lines 13-14 and column 18, lines 51-53); monitoring which of said plurality of Web sites the user accesses (see column 2, lines 14-19) and developing a profile of the user based on the profiles of the Web sites accessed by the user (updates information via view-op, see column 4, lines 26-31).

As per claim 2, Roth et al disclose demographic data (see column 2, lines 14-19).

As per claims 7-8, Roth et al disclose psychographic data, on the user's interests (viewer history data, see column 8, lines 65-67).

As per claim 9, Roth et al disclose providing a database associating each of said plurality of Web sites with demographic characteristics of known persons who have accessed said sites (database 16D, see column 18, lines 51-53).

As per claims 11-12, Roth et al disclose identifying URL requests made by the user while Web surfing and identified at an Internet Service Provider (ISP) point of presence (see column 19, lines 31-35).

As per claim 13, Roth et al disclose URL requests associated with a user and stored in a database (see column 4, lines 26-31).

As per claim 14, Roth et al disclose updating an existing user profile (see column 4, lines 30-31).

As per claim 20, Roth et al disclose delivering selective advertising to said user based on his or her profile (see column 4, lines 58-61).

Claims 22, 24, 26-29 are rejected based upon the rejection of claims 1, 9, 13, 19-21, respectively, since they are the computer claims corresponding to the method claims. Further, see column 6, lines 53-56.

As per claim 23, Roth et al disclose the computer comprising an ISP point of presence server (ISP 712 connected to servers 716, see Figure 7).

As per claim 30, Roth et al disclose the computer cooperates with a computer operated by the user to display an advertisement on a display of the computer operated by the user, said advertisement being selected from a plurality of advertisements based on the profile of the user (see column 4, lines 58-61).

As per claim 31, Roth et al disclose a system for profiling a Web user and delivering selective advertising to the user, comprising: a database containing profile data on a plurality of Web sites (web site 14, see Figure 1); means for monitoring which of said plurality of Web sites the user accesses; means for developing a profile of the user using profile data of the Web sites accessed by the user (see column 4, lines 44-49); means for matching the user with an advertisement based on the developed user profile; and means for delivering said advertisement to the user (see column 4, lines 58-61).

As per claim 32, Roth et al disclose a system for inferring a profile of a person using a client computer for Web surfing, and delivering selective advertising to the person based on his or her profile (see Figure 7), comprising: a local server computer linked to said client computer for providing Internet access (client browser 711), said local computer including means for monitoring which of said plurality of Web sites the person accesses, means for developing a profile of the person based on predetermined profile data of the Web sites accessed by the person, and means for delivering an advertisement to the client computer (server 716); and a remote server computer linked to said local server computer and including means for matching an advertisement received from an advertiser to said person based on his or her profile, and means for transmitting said advertisement to said local server computer for eventual transfer to the client computer (server 730).

As per claim 33, Roth et al disclose a local database containing data associating a plurality of Web sites with predetermined profile data on said sites (database 16B, see Figure 1).

As per claim 34, Roth et al disclose a master database containing data associating a plurality of Web sites with predetermined profile data on said sites, and wherein data in said master database is periodically synchronized with said local database. Database 16B (Figure 1) is the master and local database and synchronization is inherent.

As per claim 35, Roth et al disclose the local server computer and the remote server computer linked by an Internet connection (inter-computer network, see column 6, lines 56-58).

As per claim 36, Roth et al disclose means for delivering URL string pointing to the advertisement (see column 12, line 53).

Claims 37-50 are rejected based on the rejections of claims 2-8, 11-12, and 15-19, respectively as being the system claims corresponding to the method claims.

As per claim 51, Roth et al disclose means for monitoring how long the advertisement is displayed to the user (view-time, see column 8, lines 61-62).

As per claim 52, Roth et al disclose means for monitoring whether the user has clicked-through the advertisement (see column 8, lines 1-2).

Claim 53 is rejected based upon the rejection of claim 1, since it is the computer readable medium claim corresponding to the method claim.

As per claims 54-55, Roth et al disclose the medium comprises a removable memory (see column 9, lines 19-21), and a signal transmission (see column 10, lines 34-36).

As per claim 56, Roth et al disclose computerized method of profiling Web users and selectively delivering content to said users, comprising: providing profiles of a plurality of Web sites (web site demographics, see column 9, lines 13-14 and column 18, lines 51-53), said profiles including demographic data of persons known to have visited said sites (see column 9, lines 1-14); monitoring which of said plurality of Web sites each of said users visits; inferring a profile of each user based on the profiles of the Web sites visited by the user (see column 4, lines 44-49); identifying a target group of said users who would be receptive to receiving certain content based on their profiles; and selectively delivering the content to users of that target group (see column 13, lines 53-56).

As per claim 57, Roth et al disclose the content comprises advertisements (see column 4, lines 58-61)

As per claim 62, Roth et al does not explicitly disclose adjusting the target group to optimize user responsiveness to the content (see column 13, lines 53-64). By adjusting the criteria in Roth et al, the target group is adjusted accordingly.

As per claim 63, Roth et al disclose an advertisement, and determining user responsiveness to the content comprises determining how many users have clicked-through the advertisement (see column 2, lines 41-46).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-6, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al (USPN 6,285,987).

As per claims 3-6, Roth does not explicitly disclose including the user's age, gender, income, and highest attained education level. However, Roth discloses Web site demographics data (see column 9, lines 13-14), and it is old and well known that age, gender, income, and highest attained education level are demographic attributes, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include those attributes as part of the demographic information collected in Roth et al, thereby collecting more information on the customer, thus determining a more accurate profile.

As per claim 10, Roth et al does not disclose said database provided by a Web site ratings service. However, Roth et al disclose Web site demographic data collected from commercial sources (see column 18, lines 51-53), therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a database provided by a Web site rating service in Roth et al,

thereby providing a profile of the Website and more accurately determining the consumer profile.

9. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al (USPN 6,285,987), in view of Sheena et al (USPN 6,049,777).

As per claims 15 and 18, Roth et al does not disclose combining the profiles of the Web sites accessed by the user to the existing user profile using an averaging algorithm and the average rating is determined using a clustering algorithm. Sheena et al disclose using an averaging algorithm to calculate a similarity factor between a pair of users (see column 8, lines 47-49), based on their ratings of a product. Sheena et al also disclose clustering algorithms (see column 22, lines 33-36) used to calculate the mean of the rating given to each item a user has rated. Sheena et al also disclose the method working equally as well for items having many features of interest (see column 19, lines 9-13), such as web site and user profiles. Further, both Roth et al and Sheena et al are concerned with user profiles, and product recommendation, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include using an averaging algorithm to combine the profiles of the web site and user and determining the average rating using a clustering algorithm in Roth et al, thereby improving the profile of the user, thus providing more targeted advertisement.

As per claims 16-17, Roth et al does not disclose user profile includes data on a plurality of demographic categories, each associated with a rating, and the method

further comprises filling in a value for the rating for any demographic category having a low confidence measure and using an average rating of persons having similar profiles to that of said user for a category having a low confidence measure.

Sheena et al disclose using an averaging algorithm to calculate a similarity factor between a pair of users (see column 8, lines 47-49), based on their ratings of a product. Further, Sheena et al disclose items with low confidence factors (see column 10, line 10), and correlation between neighboring users (see column 10, lines 20-23). Both Roth et al and Sheena et al are concerned with user profiles, and product recommendation, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include filling in a value for the rating for any demographic category having a low confidence measure and using an average rating of persons having similar profiles to that of said user for a category having a low confidence measure, in Roth et al, thereby being able to fill in incomplete user profiles, thus making the method more robust.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al (USPN 6,285,987), in view of Eldering (USPN 6,298,348).

As per claim 19, Roth et al does not explicitly disclose erasing records of which Web sites said user has visited after developing the user's profile to protect user privacy. Eldering discloses maintaining consumer privacy via private data networks (see column 4, lines 62-65). Both Roth and Eldering are concerned with consumer demographic information collection, therefore it would have been obvious to one

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having ordinary skill in the art at the time the invention was made to include maintaining consumer privacy in Roth et al, as seen in Eldering, via deletion of records, thus securing consumer privacy making the system more effective.

11. Claims 21 and 58-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al (USPN 6,285,987), in view of Park et al (USPN 6,295,061).

As per claims 21 and 58-59, Roth et al does not explicitly disclose transmitting pop-up and banner advertisements to a display of a computer operated by the user. Park et al disclose banner advertisement (see column 1, lines 30-33), and pop-up advertisement over the internet (see column 2, lines 1-2). Both Roth et al and Park et al are concerned with effective advertising via the internet, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include pop-up and banner advertisement in Roth et al, as a means of reaching the consumer to provide information on a product.

As per claim 60, Roth et al disclose means for monitoring how long the advertisement is displayed to the user (view-time, see column 8, lines 61-62).

As per claim 61, Roth et al disclose means for monitoring whether the user has clicked-through the advertisement (see column 8, lines 1-2).

12. Claim 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al (USPN 6,285,987), in view of Haitsuka et al (USPN 6,366,298).

As per claim 25, Roth et al does not disclose the program including a sniffer identifying URL requests made by the user while Web surfing. Haitsuka et al discloses a client monitoring device that grabs URL's from communication stream between the browser and web server (i.e., sniffer, see column 8, lines 56-60). Both Roth and Haitsuka are concerned with the effective monitoring of on-line viewers, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a sniffer in Roth, as seen in Haitsuka, as an effective method of obtaining the viewers URL requests, thus making the Roth system more efficient.

Response to Arguments

13. In the Remarks, Applicant argues with respect to claim 1, that Roth does not disclose providing profiles on a plurality of Web sites or developing a profile of the user based on the profiles of the Web sites accessed by the user. The Examiner disagrees, and submits that Roth discloses web site demographics (see column 18, lines 51-53), as seen in the above rejection, to develop characteristics (i.e. profile) of the viewer.

With respect to claims 2, 7, and 8, Applicant argues that the information is not developed based upon the profile of the Web sites. The Examiner disagrees, and submits that Roth discloses viewer demographics as characteristics of the view-op, based upon Web sites visited. Further, with respect to claims 7 and 8, viewer history data (see column 8, lines 65-67) is based upon web site click-throughs.

With respect to claims 9-10, Applicant refers to claim 1, which is addressed above.

With respect to claims 12 and 45, the Examiner submits that Roth discloses a client browser 711 that sends web HTML references to an ISP (see column 19, lines 31-35), as seen in the above rejection.

With respect to claim 23, the Examiner submits that Roth discloses an ISP 712 connected to servers 716 (see Figure 7), as seen in the above rejection.

With respect to claim 32, the Examiner submits that Roth discloses a client browser 711 that sends web HTML references to an ISP 712 connected to servers 716, further connected to advertisers 730 (see Figure 7), as seen in the above rejection.

With respect to claim 10, the Examiner submits that Roth discloses Web site demographic data collected from commercial sources (see column 18, lines 51-53), as seen in the above rejection.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Kawasaki (USPAP 2001/0011264) discloses profiling a user of the Internet according to predefined categories of interest.


-Minor et al (USPN 5740252) discloses passing demographic information between computers.


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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (703) 305-1867. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and After Final communications, and (703) 746-7305 for informal/draft communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


adb
March 26, 2003


Susanna Ditz
Patent Examiner
Art Unit 3623